

REMARKS

Upon entry of the present amendment, claims 3, 18-19, 21-22, 25-26, and 28 will be pending in the application.

Claim 3 has been amended to. No new matter has been introduced by this amendment.

Amendments to and cancellation of the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicant's right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

1. **Rejection of claims 3, 18-19, 21-22, 25-26, and 28 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,403,701 to Reusmann et al., hereafter "Reusmann".**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

Applicants greatly appreciate the PTO's very detailed response and have attempted to respond in kind in order to move the instant application forward.

As an initial matter, Applicants and the Undersigned wish to address the issue of what Reusmann teaches and thus what is relevant in the instant obviousness rejection. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976).

Reusmann teaches a mixer system that mixes a component A with a component B. The Examiner alleges that Applicant's module (I), a nonaqueous color or effect imparting module, reads on Reusmann's component A, and that Applicant's module (III), a nonpigmented varnish module, reads on Reusmann's component B. The Examiner concedes that Reusmann does not disclose Applicant's module (II), i.e., an aqueous color imparting module.

However, the Examiner asserts that "[t]he claimed component (A2) is expected in Reusmann invention. Because, Reusmann discloses that a coating composition can be based on a plurality=various of base colors (A) separately storing each of said base colors, [...]. Also a component (A) may contain from 20 to 80% by weight of at least one water-thinnable or water-dispersible binder, [...]. A polyacrylate thickener in water is disclosed in Reusmann invention at column 16, lines 9-10. A worker in the art would add water-thinnable or water-dispersible binder with a desirable pigment to control=improve coatability property and control/correct color effect for an aqueous coating material. (4/2/2008 Office Action, page 5, first full paragraph, emphasis in original.)

Applicant respectfully disagrees.

Applicants' claimed invention is a process that requires the mixing together of three different modules, i.e., modules I, II and III as described above, and respectively, a nonaqueous color or effect imparting module, together with an aqueous color imparting module, together with a nonpigmented varnish module.

The PTO's argument above ignores the fact that Applicants' claimed process requires that the module II used therein have from 20 to 89% by weight of water. Nothing in Reusmann teaches or suggests that his disclosed process should be modified to require a separately stored *aqueous* color-imparting module be mixed with Reusmann's components A and B. Thus, Reusmann does not disclose a required limitation of Applicants' claimed mixing process. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03.

Moreover, there is simply no motivation in Reusmann to completely change Reusmann's 'substantially water-free base colors' to aqueous color imparting modules that have from 20 to 89% by weight of water. The PTO's comments provide absolutely no explanation as to how one of skill in the art would modify Reusmann's component A to have from 20 to 89 % by weight water since Reusmann's teachings disclose "...substantially water-free base colors". ('701, *Abstract*) "[S]omething in the prior art as a whole must suggest the desirability, and thus the obviousness, of making" the necessary modification. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051 5 U.S.P.Q.2d 1434, 1438 (Fed Cir.), *cert denied*, 488 U.S. 825 (1988).

In the absence of any suggestion as to how this could be done without substantially changing Reusmann's principle of operation, it is submitted that Reusmann alone cannot provide a *prima facie* case of obviousness. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959); MPEP 2143.01.

Finally, Reusmann fails to provide any expectation of success with regard to Applicants' claimed process. That is, nothing in Reusmann would lead one of skill to expect good results from mixing an aqueous color imparting module with Reusmann's components A and B. That is, one of skill in the art would reasonably expect that

Reusmann's success results from the use of a plurality of "substantially water-free base colors", i.e., that pigments should not be exposed to water.

Accordingly, no explanation has been offered as to how one of skill in the art from Reusmann alone would: (i) see Applicants' claimed process limitations, (ii) find any motivation to do what Applicants' have done, and (iii) expect success to result in the event that (i) and (ii) did occur. When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference. *In re Yates*, 211 U.S.P.Q. 1149, 1151 (C.C.P.A. 1981).

Therefore, Applicant respectfully asserts that in view of the above, independent claim 3 and all the claims depending therefrom are patentable over Reusmann under 35 U.S.C. §103(a). Reusmann does not teach or suggest all the elements of independent claim 3, as currently amended, and does not provide any motivation to modify Reusmann to arrive at Applicant's claims. The motivation provided by the Examiner is merely conclusory statements and is unsupported by Reusmann, the latter disclosing a closed ended system. In fact, Reusmann teaches away from the present claims, and the suggested modifications would change the principle of operation of Reusmann. Withdrawal of this rejection is respectfully requested.

In addition to the above, Applicants also note again that claim 22 recites that the modules comprise the at least one pigment-free rheology module (IV). That is, module (IV) is no longer optional as recited in independent claim 3. Therefore, claim 22 recites, in addition to the required three modules of claim 3, a fourth module free of pigment and comprising an aqueous medium, comprising at least one rheology control additive. Applicant respectfully asserts that claim 22 is further patentable over Reusmann at least because Reusmann does not teach or suggest Applicant's four separate modules as recited in claim 22 and the claims depending therefrom.

2. **Rejection of claims 3, 18-19, 21-22, 25-26, and 28 under 35 U.S.C. §103(a) as allegedly unpatentable over Reusmann in view of U.S. Patent No. 6,001,915 to Schwarte et al., hereafter "Schwarte".**

As discussed above and conceded by the Examiner, Reusmann does not teach or suggest Applicant's module (II). However, the Examiner relies on Schwarte to remedy the deficiencies in Reusmann. Applicant appreciates the detailed basis of rejection but must respectfully disagree and hereby incorporates the discussion of Section 1 above herein.

The Examiner supports this position by stating that "any additional compound as a tinting base color comprising water-dilutable binder is expected in Reusmann invention." (4/2/2008 Office Action, page 6, second paragraph.)

Applicants' must respectfully disagree.

Schwarte merely discloses a polyurethane modified acrylic that can be used in basecoats, clearcoats, and powder coatings. (See '915, col. 8, ll. 15-67- col. 9, ll1-24) The Undersigned has carefully reviewed Schwarte but has failed to find any mention whatsoever of ***'separately stored mixing modules differing in material composition and function'*** as is required in the process of Applicants' independent claim 3. Rather, Schwarte's discussions of basecoats, clearcoats (solvent and water based) and powder coatings appear to be limited to traditional coating systems that are not comprised of separate modules that have different composition and function and are stored separately until shortly before application or are used in any processes requiring the same. Thus, none of Schwarte's disclosures appear to be relevant with regard to Reusmann's deficiencies as discussed above.

The Undersigned respectfully requests clarification as to how Schwarte provides any of the missing limitations, motivation or expectation of success that Reusmann fails to provide as discussed above.

In view of the above, Applicant respectfully asserts that the independent claim 3 and all the claims depending therefrom are patentable over the combination Reusmann and Schwarte, at least because there is no suggestion or motivation to combine Schwarte

with Reusmann, and because such combination would render Reusmann unsatisfactory for its intended purpose, the latter teaching away from including any mixer systems other than A and B. Withdrawal of this rejection is respectfully requested.

In addition to the above, claim 22 recites that the modules comprise the at least one pigment-free rheology module (IV). That is, module (IV) is no longer optional as recited in independent claim 3. Therefore, claim 22 recites, in addition to the required three modules of claim 3, a forth module free of pigment and comprising an aqueous medium, comprising at least one rheology control additive. Applicant respectfully asserts that claim 22 is further patentable over Reusmann and Schwarted at least because the combination of Reusmann and Schwarte does not teach or suggest Applicant's four separate modules as recited in claim 22 and the claims depending therefrom.

3. Rejection of claims 3, 18-19, 21-22, 25-26, and 28 under 35 U.S.C. §103(a) as allegedly unpatentable over Reusmann, in view of EP 0 081 994 to Kawakami et al., hereafter “Kawakami”.

The Examiner relies on Kawakami to remedy the above described deficiencies in Reusmann. However, Applicant respectfully asserts that there is no suggestion or motivation for the combination of Kawakami with Reusmann, nor is there a reasonable expectation of success. In fact, such a combination would be improper for at least the following reasons.

Kawakami discloses a thermosetting resin prepared by mixing or reacting an alkylene diamine or polyalkylenepolyamine with an epihalohydrin, and a water-soluble resin obtained by reacting urea, a polyalkylenepolyamine, and a dibasic carboxylic acid and reacting the resultant polyamidopolyurea formaldehyde. (Kawakami, abstract). Kawakami's resin is thus substantially different from Reusmann's binder (B).

The Undersigned has carefully reviewed Kawakami but has failed to find any mention whatsoever of '*separately stored mixing modules differing in material composition and function*' as is required of Applicants' independent claim 3. Thus, none of Kawakami's disclosures appear to be relevant with regard to Reusmann's deficiencies as discussed above.

The Undersigned respectfully requests clarification as to how Kawakami provides any of the missing limitations, motivation or expectation of success that Reusmann fails to provide as discussed above.

In view of the above, Applicant respectfully asserts that independent claim 3 and all the claims depending therefrom are patentable over the combination of Reusmann and Kawakami. Withdrawal of this rejection is respectfully requested.

In addition to the above, claim 22 recites that the modules comprise the at least one pigment-free rheology module (IV). That is, module (IV) is no longer optional as recited in independent claim 3. Therefore, claim 22 recites, in addition to the required three modules of claim 3, a forth module free of pigment and comprising an aqueous medium, comprising at least one rheology control additive. Applicant respectfully asserts that claim 22 is further patentable over Reusmann and Kawakami at least because the combination of Reusmann and Kawakami does not teach or suggest Applicant's four separate modules as recited in claim 22 and the claims depending therefrom.

Applicant further traverses the remaining assertions set forth in the office action, including the teachings of the various references. However, since these references fail to render the claims obvious for at least the reasons set forth above, these assertions are moot and are therefore not specifically addressed in detail.

CONCLUSION

Applicant respectfully submits that the Application and pending claims are patentable in view of the foregoing amendments and remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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